

## **REMARKS**

### **Status of the Claims**

The Office Action dated May 20, 2004 has been received and its contents carefully considered. Claims 1-25 are pending. Claims 1-25 have been rejected. Claims 1, 20 and 21 have been amended. Claims 6 and 24 have been canceled.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

### **Office Action**

Claims 1-4, 10 and 21 were rejected under 35 U.S.C. §102(b) as being anticipated by Arjomand. Without conceding the propriety of the rejection, independent claims 1 and 21 have been amended. It is respectfully submitted that Arjomand does not teach, *inter alia*, a diagnostic tool for communicating with a vehicular electronic control unit comprising a user interface having at least one integrally connected computer media port received in a portable media device, wherein the media port is configured to serve as a basis for updating of at least one of a diagnostic application program and memory of said tool, “wherein said user interface includes a smart card for controlling authorized access of diagnostics application programs” as recited in Claim 1.

It is also respectfully submitted that Arjomand does not teach, *inter alia*, a diagnostic tool for communicating with a vehicular electronic control unit comprising means for interfacing with the diagnostic tool having at least one integrally connected computer media port for receiving a portable media device, “wherein the media port is configured to serve as a basis for updating at least one of a diagnostic application program

and a memory of said tool... and means for determining whether a valid smart card is present” as recited in claim 21.

Arjomand discloses a modular wireless diagnostic test and information, including a main control module 12, a digital volt ohm meter 16, a vehicle communication interface 14, an engine analyzer 48, and an interface module 46. These components are utilized separately and independently in order to communicate, for instance, to an operator and/or to provide upgrading functions. The aforementioned features work in contrast to the present invention, which utilizes a portable media device that is configured to serve as a basis for updating of at least one of a diagnostic application program and memory of the diagnostic tool and is directly received through an integral connection of a computer media port for the user interface of the diagnostic tool. Furthermore, Arjomand does not teach a user interface to include a smart card for controlling authorized access of diagnostics application programs as recited by claim 1 of the present invention. Arjomand is also silent with regards to teaching a means for determining whether a valid smart card is present on the diagnostic tool as recited in claim 21 of the present invention.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P., Arjomand cannot be said to anticipate the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 2-4 and 10 ultimately depend from independent claim 1 and are patentable over the cited prior art for at least the same reasons as is claim 1.

Claims 4-9, 11-20 and 22-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Arjomand. Claims 4-5 and 7-19 ultimately depend from independent claim 1. Claim 6 was canceled. Claims 22-23 and 25 ultimately depend from independent claim 21. Claim 24 was canceled. Arjomand fails to teach the features as recited in independent claims 1 and 21 as presented above. Without conceding the propriety of the rejections, independent claim 20 has been amended. It is respectfully submitted that Arjomand does not teach, *inter alia*, a method of remotely updating diagnostic application programs residing in at least one of internal and external memory of a portable diagnostic tool comprising providing a diagnostic tool and “determining whether a valid smart card is present” in combination with the rest of the claimed features as recited in claim 20. No smart card is taught by Arjomand.

In rejecting claims under 35 U.S.C. §103, an Examiner bears an initial burden of presenting a *prima facie* case of obviousness. A *prima facie* case of obviousness is established only if the teachings of the prior art would have suggested the claimed subject matter to a person of ordinary skill in the art. If an Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See *In re Rijckaert*, 9 F.3d 1531, 28 U.S.P.Q. 2d 1955 (Fed. Cir. 1993). “If examination ... does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to the grant of the patent.” *In re Oetiker*, 977 f.2d 1443, 1445-1446, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992).

A *prima facie* case of obviousness has not been made in that Arjomand teaches or suggests the invention recited claims 4-5, 7-9, 22-23, and 25. The Examiner merely concludes that “specific details falls within the realm of engineer and design choice for

meeting customers' expectation and specification" (see previous office action, page 3, paragraph 6). The Examiner has failed to rely on additional references to cure the deficiencies of Arjomand, and thus if a rejection on this basis is maintained, it is respectfully requested that the Examiner provide a reference or elaboration in support of the rejection.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Since the prior art does not teach or suggest all the claimed features, withdrawal of the rejection is respectfully requested.

### **CONCLUSION**

In view of the foregoing, reconsideration and allowance of the application are believed in order and such action is earnestly solicited.

87355.1601  
Customer No. 30734

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned agent at 202/861-1538.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'Marc W. Butler', with a stylized flourish extending to the right.

Marc W. Butler

Registration No. 50,219

Washington Square, Suite 1100  
1050 Connecticut Avenue, N.W.  
Washington, D.C. 20036-5304  
Telephone: 202/861-1655  
Facsimile: 202/861-1783  
**Date: August 20, 2004**